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7590 05/04/2004 David J. Gaskey CARLSON, GASKEY & OLDS, P.C. Suite 350 400 West Maple Road Birmingham, MI 48009			EXAMINER FLANDRO, RYAN M	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040422

Application Number: 10/036,678
Filing Date: December 21, 2001
Appellant(s): TRAKTOVENKO ET AL.

David J. Gaskey, Reg. No. 37,139
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 February 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 13-19, 23, 24 and 26.

Claims 13-16, 19 and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schmidt (US 5,243,921).

Claims 13-18, 24 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Brendal et al (US 4,536,921).

The rejection of claims 17 and 26 under 35 U.S.C. §103(a) as being unpatentable over Schmidt in view of Reynolds (US 2,085,333) is hereby withdrawn, thus rendering Appellant's arguments moot with regard to these rejections. As noted above, however, claims 17 and 26 are still rejected as being anticipated by Brendal.

Claims 1-4, 10-12, 20, 21 and 28 have been allowed.

Claim 25 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5-9 were withdrawn from consideration as not directed to the elected species.

These claims will be rejoined when the case is in condition for allowance.

Claims 22 and 27 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct (i.e., there are no un-entered amendments as of the filing of the appeal brief). The amendment after final rejection filed on 4 December 2003 has been entered. In the Advisory Action mailed 12 December 2003, the Examiner incorrectly checked the "will not be entered" box under category 7 and noted the same on the cover sheet of the amendment. This was in error. The Examiner has since sent out a supplemental Advisory Action indicating that the amendment was entered upon appeal and also correctly indicated as much on the cover sheet of the amendment. Accordingly, there are no un-entered amendments.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the rejection of claims 17 and 26 under 35 U.S.C. §103(a) based upon the combination of Schmidt in view of Reynolds has been withdrawn, thus rendering the issue moot.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 13-19, 23, 24 and 26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,243,739	Schmidt	9-1993
4,536,921	Brendal et al.	8-1985

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102; Findings

Claims 13-16, 19, and 23 were rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt (US 5,243,739).

Claim 13. Schmidt shows a socket portion **11** having oppositely facing engaging surfaces (inside surfaces of walls **20**) inside the socket portion **11**; and a wedge portion **52** that is at least partially received within the socket portion **11** such that a portion of the elongated load bearing member **62** is received between the engaging surfaces **20** of the socket portion **11** and the wedge portion **52** (see figures 1-3).

Claim 14. Schmidt shows at least one brace member **15** that secures the wedge portion **52** within the socket portion **11** (see figures 1-3).

Claim 15. Schmidt shows that the brace member **15** is a metal piece (see figures 1-3).

Claim 16. Schmidt shows the socket **11** including a projection **60** that operates to hold the brace **15** in place on the socket **11** (see figures 1-3).

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Claim 19. Schmidt shows a brace portion **36** that secures the wedge portion **52** within the socket portion **11** and wherein the brace portion **36** includes a load bearing member engaging surface (hidden underside of element **44**) that is adapted to secure a portion of the load bearing member **62** between the brace member **15** and the socket portion **11** (figures 2-3).

Claim 23. Schmidt shows the engaging surfaces (inwardly facing surfaces of walls **20**) on the socket portion **11** being part of a continuous engaging surface (circumscribing receptacle **21**) inside the socket portion **11** (see figures 1-3).

Claims 13-18, 24 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Brendal (US 5,243,739).

Claim 13. Brendal clearly shows and discloses a socket portion **2,7** having oppositely facing engaging surfaces **5** (inside surfaces of walls of **2,7** – see figures 7-10) inside the socket portion **2,7**; and a wedge portion **9** that is at least partially received within the socket portion **2,7** such that a portion of an elongated load bearing member **6** is received between the engaging surfaces **5** of the socket portion **2,7** and the wedge portion **9** (see figures 1-6; see especially column 5 lines 32-39).

Claim 14. Brendal shows at least one brace member **12** that secures the wedge portion **9** within the socket portion **2,7** (see figures 1-3).

Claim 15. Brendal shows that the brace member **12** is a metal piece (see figures 1-3; see column 8 lines 42-47).

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Claim 16. Brendal shows the socket **2,7** including a projection **15 or 22** that operates to hold the brace **12** in place on the socket **2,7** (see figures 1-3).

Claim 17. Brendal further shows the brace **12** including an opening (circumscribed by element **14**) through at least one sidewall of the brace **12** and the wedge portion **9** includes an opening **10**, the openings being situated such that a tool can be received into the openings and utilized to manipulate the wedge portion **9** relative to the brace **12** (see figures 1-3).

Claim 18. Brendal shows and discloses the socket portion **2,7** including a first leg **2** and a second leg **7**, the first leg **2** being obliquely oriented relative to the second leg **7** (see figures 2 and 3) and being movable into a generally parallel alignment with the second leg **7** (see figures 1 and 4) responsive to movement of the wedge portion **9** within the socket portion **2,7** (see figures 1-4).

Claim 24. Brendal, as applied to claim 1 above, further shows the wedge portion **9** having oppositely facing engaging surfaces **5'** (see figures 14 and 19) on an outside of the wedge portion **9** and wherein one section of the elongated load bearing member **6** is held between one of the wedge portion engaging surfaces **5'** and one of the socket portion engaging surfaces **5** and wherein another section of the load bearing member is held between the other wedge portion engaging surface **5'** and the other socket portion engaging surface **5** (see figures 1-3, 7-10, and especially figure 5).

Claim 26. Brendal shows a socket portion **2,7**; a wedge portion **9** that is at least partially received within the socket portion **2,7** such that a portion of an elongated

load bearing member 6 is received between the socket portion 2,7 and the wedge portion 9; and at least one brace member 12 that secures the wedge portion 9 within the socket portion 2,7, the brace member 12 including an opening (circumscribed by element 14) through at least one wall of the brace member 12 and the wedge portion 9 including an opening 10, the openings being situated such that a tool can be received into the openings and utilized to manipulate the wedge portion 9 relative to the brace 12 (see figures 1-4).

(11) Response to Argument

Claims 13-19, 23, 24 and 26 are anticipated under the findings set forth above. This position is supported in view of the following arguments.

Anticipation is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, e.g., In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Additionally, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the Appellant is claiming, but only that the claim on appeal “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

The Rejection under 102(b) based upon Schmidt

Appellant presents 3 main arguments against the claims rejected under Schmidt: (1) lack of “extruded” pieces in Schmidt; (2) lack of “oppositely facing engaging surfaces inside the socket portion”; and (3) with regard to claim 19, lack of “a brace member having a load bearing member engaging surface adapted to secure a portion of a load bearing member between the brace member and the socket portion.” Each argument is addressed below.

Extrusion. First, with regard to claim 13, Appellant argues that Schmidt fails to disclose that the socket portion or the wedge portion are **extruded** as recited in the claims. As set forth in the Advisory Action mailed 12 December 2003, however, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this recitation was given little, if any, patentable weight and the Examiner maintains that this recitation does not distinguish over the structure of the prior art. Notably, the Examiner indicated claim 28 as allowable because it recited a structural limitation (a constant cross-sectional profile) which read over the prior art. That is, when a structural limitation inherent to an extruded element was recited in the claims, allowability was indicated. On the other hand, where a method of forming a device was recited without additional structural limitations, the claims were deemed to be anticipated by the prior art.

Moreover, the Examiner’s position that the recitation of the term “extruded” is merely a method of forming and not a structural limitation is bolstered by Appellant’s own argument. For example, at page 7 of the Brief, Appellant points out that “[t]he Schmidt reference nowhere discloses how the portions of the arrangement are *formed*. Perhaps a casting or forging process

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could be used,” and also that “[i]t is impossible to conceive of a die through which metal could be forced to *result* in any of the components of the Schmidt reference” (emphasis added).

Also, at page 10 of the Brief, Appellant argues that the limitation is not a product-by-process limitation, but then cites MPEP 2113 as requiring consideration of the limitation for patentability purposes. MPEP 2113 specifically addresses product-by-process claims. Thus, the Examiner agrees that the limitation is not a product-by-process limitation and, in turn, that MPEP 2113 is not applicable here. The rejection should be upheld under the aforementioned principles of patent claim construction.

Oppositely facing engaging surfaces. Second, Appellant argues that Schmidt does not disclose oppositely facing engaging surfaces inside the socket portion. As pointed out by Appellant, the Examiner interprets the walls **20** on the inside of the socket housing assembly **11** of Schmidt as being oppositely facing engaging surfaces. Moreover, the Examiner interprets Schmidt as having a portion of the elongated load bearing member **62** received between the engaging surfaces **20** of the socket portion **11** and the wedge portion **52** (see figure 4). Importantly, Appellant further argues that “[t]here is no engagement between [the] walls **20** and the cable **62** of the Schmidt reference.” The Examiner agrees, but notes that **the claim does not require that the oppositely facing engaging surfaces engage the cable**, only that they engage something. As shown in Schmidt figure 4, the walls **20** are oppositely facing surfaces that *engage* the walls **56** of the wedge **52** and are therefore properly considered to be “oppositely facing engaging surfaces” within the language of the claim. Moreover, Schmidt (figure 4) shows a portion of the elongated load bearing member **62** being received *between* the engaging surfaces

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20 of the socket portion 11 and the wedge portion 52. For example, in figure 4, the elongated load bearing member 62 lies *between* the left wall 20 and a right portion of wedge channel 54.

Thus, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., engagement between the oppositely facing engaging surfaces and the elongated load bearing member) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Brace portion including a load bearing member engaging surface. Lastly, with regard to the rejection of claim 19, Appellant argues that brace portion 15 of Schmidt “does not have any surface that engages the cable 62 between such a surface and an outside surface on the socket housing assembly 11” (Brief page 11). Again, the Examiner points out that Appellant is reading limitations from the specification into the claims. Tracing the language of the claim in relevant part, Schmidt shows a brace portion 15 including a load bearing member engaging surface (see Schmidt figures 2 and 4 – inside surface of element 44) that is adapted to secure a portion of the load bearing member 62 *between* the brace portion 15 and the socket portion 11. That is, Schmidt shows a portion of the load bearing member 62 *between* the brace portion 15 and the socket portion 11. The term “between” is broadly construed and the claim does not require that the load bearing member be engaged by an “outside surface of the socket portion” as alleged by Appellant in the Brief.

Thus, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e.,

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engagement between a load member engaging surface of the brace member and an outside surface of the socket portion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Rejection under 102(b) based upon Brendal

Appellant also presents 2 main arguments against the claims rejected under Brendal: (1) with regard to claim 12, Brendal lacks “extruded” pieces; and (2) with regard to claims 17 and 26, Brendal lacks openings in the brace and wedge portion situated such that a tool can be received into them and utilized to manipulate the wedge portion relative to the brace.

Extrusion. First, with regard to claim 13 and as substantially set forth above in the rebuttle of arguments against Schmidt, Appellant argues that Brendal fails to disclose that the socket portion or the wedge portion are **extruded** as recited in the claims. As set forth in the Advisory Action mailed 12 December 2003, however, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this recitation was given little, if any, patentable weight and the Examiner maintains that this recitation does not distinguish over the structure of the prior art. Notably, the Examiner indicated claim 28 as allowable because it recited a structural limitation (a constant cross-sectional profile) which read over the prior art. That is, when a structural limitation inherent to an extruded piece was recited in the claims, allowability was indicated. On the other hand, where a method of forming a device was recited without additional structural limitations, the claims were deemed to be anticipated by the prior art.

Moreover, the Examiner's position that the recitation of the term "extruded" is merely a method of forming and not a structural limitation is bolstered by Appellant's own argument. For example, at page 13 of the Brief, Appellant points out that "[t]he Brendal reference...specifically teaches that the individual parts shown in that reference can be *shaped or formed* using punches or presses or casting," and also that "[a] basic understanding of an extrusion *process* where a material such as metal is forced through a die requires that one interpret Brendal as not teaching an extruded socket nor an extruded wedge" (emphasis added). Thus, as above, the rejection should be upheld under the aforementioned principles of patent claim construction.

Openings. Second, with regard to claims 17 and 26, Appellant argues that Brendal lacks disclosure of the recited openings in the brace and wedge portion situated such that a tool can be received into them and utilized to manipulate the wedge portion relative to the brace. The Examiner respectfully disagrees. As pointed out in the rejection findings above, Brendal shows the brace portion **12** having an opening (area circumscribed by element **14**) and also shows the wedge portion **9** having an opening **10** (see figures 1-4). Brendal further shows the openings being situated (see figure 3) such that a tool *can be* received by them for manipulating the wedge portion **9** relative to the brace **12**. Importantly, opening **10** is shown as an elongated slot having a bolt **11** situated therein. Even when, as Appellant argues, the Brendal device is "locked in position" as shown in figure 3, the openings are situated such that a tool *can be* received by them for manipulating the wedge portion **9** relative to the brace **12**. That is, a tool can be used to manipulate the bolt **11** such that it slides within the opening **10** (see column 5 line 58 – column 6 line 6), allowing relative movement between the wedge **9** and the brace **12**.

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In the alternative, the Examiner points out that the bolt **11** may properly be considered a "tool" which can be received in the openings, thus allowing for the wedge portion **9** to be manipulated relative to the brace **12** (see figures 1-3). This alternative understanding also anticipates the claim as currently recited.


Conclusion


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


RMF
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